

REMARKS

The amendments in Paragraph [0006] are corrections of minor clerical errors, the need for which is apparent from Office records. The list of patents and applications in this Paragraph is stated to be E Ink and MIT patents relating to electrophoretic displays. U.S. Patent No. 6,249,721 is not assigned to either E Ink or MIT and does not relate to this technology. Hence, correction is obviously required, and Office records show that the correct Patent No. 6,249,271 must be intended. Similarly, there is no published Application No. 2003/01151702, and Office records readily indicate the correct number. The amendment in Paragraph [0007] simply adds a publication number to a reference to an International Application previously identified only by its application number. Finally, the amendment in Paragraph [0050] corrects an obvious clerical error. No new matter is introduced by any of these amendments.

Claims 1-34 are present in the application and all are rejected under 35 USC 102(e). The rejections are traversed.

Firstly, claims 1-6, 10-18, 20-25 and 28-33 are rejected under 35 USC 102(e) as anticipated by Jacobson, U.S. Patent 5,961,804. This rejection is traversed on the grounds that Jacobson is not available as a reference against this application under 35 USC 102(e).

Jacobson issued on Application Serial No. 08/819,320, filed **March 18, 1997**. As noted in Paragraph [0001], this Application is a continuation-in-part of copending Application Serial No. 08/983,404, filed March 26, 1999, which is the United States National Phase of International Application No. PCT/US96/12000, filed **July 19, 1996** (and published as WO 97/04398 - copy attached). In so far as relevant to the present claims, the disclosure in WO 97/04398, which also names Jacobson as its sole inventor, includes all of the relevant disclosure in Jacobson. In particular, Figure 4A and the related description of Jacobson, to which the Examiner refers at length in Paragraph 2 of the Office Action, are essentially reproduced as Figure 7E and accompanying description of WO 97/04398. Thus, since this application claims benefit of

PCT/US96/12000, which was filed earlier than Jacobson and contains the same relevant disclosure, Jacobson is not available as a 35 USC 102(e) reference against this application.

The Examiner's attention is respectfully directed to the fact that the aforementioned copending Application Serial No. 08/983,404 has been allowed by the present Examiner with claims directed to certain types of dielectrophoretic displays. The Examiner may wish to review the relationship between the claims of this allowed application and the present claims.

Claims 1, 7-9, 19, 20, 26, 27 and 34 stand rejected under 35 USC 102(e) as anticipated by Liang et al, 2003/0048522. This rejection is traversed on the grounds that (a) Liang does not unambiguously disclose any display having "means for applying to the substrate an electric field effective to cause dielectrophoretic movement of the particles to the side wall of the cavity" as required by all the present claims; and (b) Liang is not available as a 35 USC 102(e) reference against this application.

With regard to (a), it is respectfully noted that Liang never identifies the way in which the particles in the embodiment of Figure 5 are driven. The only relevant passages in Liang appear to be Paragraph [0049], which states that "The display may have the traditional up/down switching mode, the in-plane switching mode or the dual switching mode", Paragraph [0051], which states "In the display having the in-plane switching mode, the cells are sandwiched between a top transparent insulator layer and a bottom electrode plate. The in-plane switching mode allows the particles to move in the planar direction only", and Paragraph [0058], which states that "FIG. 5 also shows the display driven by an in-plane switch mode." It is respectfully noted that movement of the electrophoretic particles to the sidewall of a microcell, as illustrated in Figure 5 of Liang, does not imply dielectrophoretic movement, and indeed the reference in Paragraph [0051] to electrodes being present on only one side of the electrophoretic medium for in-plane switching tends to suggest that dielectrophoretic particle movement is not being used and the particles are driven the sidewalls of the cells by applying to the rear electrode of the

relevant cell a voltage of the same polarity as the charge on the particles, and applying to the rear electrodes of adjacent cells a voltage of the opposite polarity, which would cause the lines of force to assume substantially the form of semi-circles with both ends of the lines on rear electrodes, and hence cause the particles to move to the cell walls under normal electrophoretic forces. In any event, clearly Liang does not disclose "means for applying to the substrate an electric field effective to cause dielectrophoretic movement of the particles" in the unambiguous manner required to found a rejection under 35 USC 102(e).

With regard to (b), it is believed that the discussion of Jacobson above will show that the present applicants were in possession of the invention prior to the earliest possible date to which Liang can be entitled under 35 USC 102(e), namely the September 13, 2001 filing date of the associated provisional application. However, lest the Examiner maintain that some claims are not based upon the aforementioned copending Application Serial No. 08/983,404, there is filed herewith a Declaration under 37 CFR 1.131 by the inventor Alexi Arango showing that he was in possession of the invention prior to the earliest date to which Liang can be entitled. (It is regretted that, because of time constraints and the fact that Mr. Arango is no longer employed by E Ink Corporation, the copy of the Declaration filed herewith is unsigned; a signed copy will be supplied in the very near future.) Accordingly, Liang is not available as a 35 USC 102(e) reference against this application.

For the foregoing reasons, the 35 USC 102(e) rejections are unjustified and should be withdrawn.

Since the normal period for responding to the Office Action expired November 25, a Petition for a three-month extension of this period is filed herewith. An Information Disclosure Statement is also being filed herewith; this Information Disclosure Statement comprises both paper and electronic parts, and as explained in the paper part, the fee for the late filing of this Information Disclosure Statement is being

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paid with the first of the electronic parts thereof. The undersigned attorney would apologize for the late filing of this Information Disclosure Statement.

Reconsideration and allowance of all claims in this application is respectfully requested.

Respectfully submitted

A handwritten signature in cursive script, appearing to read "David J. Cole".

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